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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/589,220 | 05/21/2007 | David M. Perrin | 58192/S318 | 5776 |

23363 7590 04/15/2011
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| EXAMINER |
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SAMALA, JAGADISHWAR RAO

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| ART UNIT | PAPER NUMBER |
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1618

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| MAIL DATE | DELIVERY MODE |
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04/15/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/589,220

Applicant(s)

PERRIN ET AL.

Examiner

JAGADISHWAR SAMALA

Art Unit

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12,14,15,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12,14,15,19 and 20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 03/11/2006, 05/21/2007, 06/04/2007 & -6/23/2010.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Applicant's election without traverse of Group I, claims 1-20 in the reply filed on 01/18/2011 is acknowledged. Applicant's election of species G is boron and R is an aryl group is acknowledged. Accordingly, the claims 1-2, 4-12, 14-15 and 19-20 reads on elected species and presented for examination.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 08/11/2006, 05/21/2007, 06/04/2007 and 06/23/2010 were noted and the submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 4-12, 14-15 and 19-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to a compound of the formula $(F)_m G (R)_n$, wherein at least one F is ^{18}F , G is boron or silicon, and R is aryl moiety capable of bonding to a biomolecule.

The first paragraph of 35 USC 112 requires that the specification contain a written description of the invention. Accordingly, where a particular compound has not been specifically named or "otherwise exemplified", one is left to select from mere possibilities encompassed by the broad disclosure, with no guide indicating or directing that this particular selection should be made rather than any of the many others which could also be made. *In re Ruschi*, 154 USPQ 118, 122 (CCPA 1967). As elaborated by the court:

Specific claims to single compounds require reasonably specific supporting disclosure and while we agree with the appellants, as the board did, that naming is not essential, something more than the disclosure of a class of 1000, or 100, or even 48, compounds is required. Surely, given time, a chemist could name (especially with the aid of a computer) all of the half million compounds within the scope of the broadest claim, which claim is supported by the broad disclosure. This does not constitute support for each compound individually when separately claimed.

Here, the claims are devoid of any structural elements that correlate to the function which is to be achieved with the claimed compound. For example, a vast numbers of potential "aryl moieties have an affinity to bind with a biomolecule may be found in the art to be capable of having the claimed function. The specification discloses examples of some variety of aminophenyl borate molecules which can bond to a biomolecule ... (page 29 and 30). Such aryl moieties are widely varying in structure and would have an almost unlimited number of potential aryl moieties which may have affinity to bind thereto. It is clear that Applicant had possession of such a few specific

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formulations at the time of filing using specific and defined aryl moieties as identified in page 29 and 30 and the Examples, but the specification as originally filed does not provide support that Applicant had possession of the invention as generically claimed by function alone in the instant claims. Applicant's limited disclosure of a particular compound which has the claimed functional properties does not provide support that Applicant envisaged the invention as a whole which is broadly claimed solely by function. In the instant case, a definition by function alone does not appear to sufficiently describe the claimed invention because it is only an indication of what the agent does, rather than what it is. See MPEP 2163 and *Eli Lilly*, 119 F.3 at 1568, 43 USPQ2d at 1406.

Conclusion

No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGADISHWAR SAMALA whose telephone number is (571)272-9927. The examiner can normally be reached on 8.30 A.M to 5.00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571)272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jake M. Vu/
Primary Examiner, Art Unit 1618

Jagadishwar R Samala
Examiner
Art Unit 1618